

In re Patent Application of
Pierson et al
Serial No. 09/596,374
Filed June 19, 2000

REMARKS

Applicant herein responds to the outstanding Office action.

The Previously Filed Supplemental IDS

Applicants acknowledge that the Examiner has indicated that one reference listed in the previously filed IDS was designated by an incorrect Patent number. Applicants have verified that the Rose reference is US Patent No. RE38,290 E, issued on October 28, 2003, and which was a reissue of Patent No. 5,844,757, issued on December 1, 1998, and respectfully request that the Examiner consider said reference.

The Claims Recite At Least One Novel Feature Over The Cited Reference

The Examiner has maintained the previous rejection of all pending claims under 37 U.S.C. 102(e) as anticipated by Sanford (US 6,536,039). For the reasons explained below, Applicants respectfully disagree. While various claims have been clarified, these remarks focus on independent claims 1, 6, 11 and 12, since if these claims are found patentable, their respective dependent claims will be patentable as well.

Amended independent claims 1, 6, 11 and 12 to more clearly recite a major novel feature of the present invention over the Sanford reference. Specifically, the present invention updates by downloading and storing in the computer's hard drive only differences in digital information between new updates and the original content data on the CD, rather than by downloading complete program modules, as taught by Sanford. This novel feature of the present invention is further distinguished from Sanford in the discussion set out below. The language of the claims has been additionally clarified by substituting the term "information" for the term "data." These two terms are essentially interchangeable, as explained in the application as filed, on page 9, line 4.

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The Sanford reference describes a "program module" as algorithms, content, or both (see column 3, lines 37-39). Nevertheless, Sanford teaches that discrete "program modules" are pre-identified for the user by listing on the screen display and that the user then choose to either select one of these pre-identified program modules or select a new program module (see FIG. 1, blocks 105 and 120). Thus, in order to download a change, the user must download a complete pre-identified program module, which includes changed digital information, but which also includes information in the program module which has not been changed. Accordingly, the Sanford invention suffers from certain inefficiency by requiring download of more than just the necessary changes.

In contrast, however, the presently claimed invention does not require that program modules be pre-identified because *updating downloads include only differences in the information content between the original digital information and the updated or new information*, so that it is immaterial where these differences occur and the invention avoids Sanford's approach of having to download unchanged content along with the changed content. For an explanation of how this feature of the present invention operates, please see the application as filed at page 12, line 24, through page 13, line 19.

There is little question that Sanford teaches downloading complete program modules, as the reference is replete with statements to that effect. The Sanford reference teaches that the user may choose to download updated or new program modules. **"The user can download individual updated program modules and/or content, instead of an entire software program or complete content, from a designated information site through a data server to a PC hard disk drive during a program run."** See col. 2, lines 11-16; emphasis added. **"The user can download the updated program modules as needed during the program run."** See col. 2, lines 24-25; emphasis added. **"If the user chooses to download a new program module** The new program module will be run from the

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PC hard disk drive." See col. 2, lines 53-54 and 61-62; emphasis added. "***The user may download updated program modules*** from the designated Information site to the PC hard disk drive as needed during a program run." See, col. 3, lines 4-6; emphasis added. "***The user can download the updated program modules as needed*** during the program run." See col. 5, lines 49-50; emphasis added.

Those skilled in software understand that a "module" is a self-contained part of a larger set of digital information, that is, typically a small program that handles a specific function or routine, as recognized by the Examiner. From its description, it is clear that the Sanford invention teaches updating CD files by downloading and storing only complete program modules to the computer's hard drive. Several further examples of Sanford's description are listed below which support that interpretation.

"The finite set of program modules listed on the main screen reside on the CD. However, if the chosen program module also exists on the PC hard disk drive, ***the program module on the PC hard disk drive is a replacement program module for the original program module residing on the CD.*** One or more of the finite set of program modules on the CD may be replaced by replacement program modules." See col. 3, lines 61-66; emphasis added.

"Replacement of one of the finite set of program modules on the CD occurs by ***downloading a replacement program module*** from the designated information site through the data server to the PC hard disk drive." Sanford, col. 4, lines 1-5; emphasis added.

"If a ***replacement program module for the chosen program module exists on the PC hard disk drive*** 106, then the program runs the chosen program module residing on the PC hard disk drive 110. If a replacement program module does not exist for the chosen program module, the program runs the chosen program module residing on the CD

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115. The user may then run another program module from either the CD or the PC hard disk drive from the main screen 101." See col. 4, lines 41-49; emphasis added.

"Downloading individual program modules during a program run deletes the extra step of downloading the entire updated software program before running the updated software program. Also, **downloading individual modules from the information site as needed** can be done in a more timely manner than using an updated software program on the designated information site by direct interactivity between the user's PC and the designated information site." See col. 5, 37-45; emphasis added.

"Therefore, the present invention [by Sanford] provides users with seamless interconnectivity between program modules on a CD, **downloaded program modules on a PC hard disk drive**, and **any replacement or additional program modules on the designated information site**." See col. 6, lines 13-17; emphasis added.

Applicants respectfully point out that it is clear that the Sanford reference neither discloses nor fairly suggests updating a CD by downloading *only differences in digital content between the original and the new or updated information*. Thus, the present invention functions much more efficiently than Sanford's, which requires downloading a complete program module, including the portions of the program module in which no changes were made to the digital information.

Since the claimed invention recites at least that novel feature not disclosed by Sanford, there is no anticipation by that reference. Applicants, therefore, respectfully request that the Examiner withdraw the rejection of the claims on that basis.

Conclusion

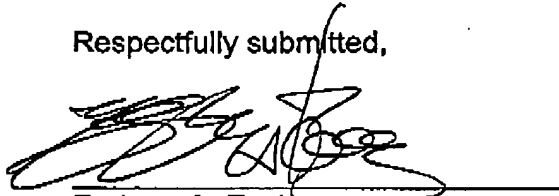
In view of the amendments and the remarks presented herein, it is submitted that the pending independent claims are patentable. In addition, their respective dependent

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claims, which recite yet further distinguishing features, are also patentable and require no further discussion.

If the further prosecution of this application may be facilitated through a telephone conference between the Examiner and the undersigned, the Examiner is respectfully requested to call.

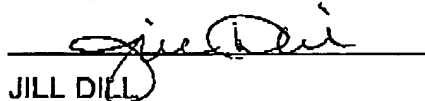
Respectfully submitted,



Enrique G. Estévez
Reg. No. 37,823
Allen, Dyer, Doppelt, Milbrath & Gilchrist, P.A.
255 S. Orange Ave., Suite 1401
P. O. Box 3791
Orlando, Florida 32802
(407) 841-2330

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JILL DILL